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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/025,742	12/26/2001	John Tiong-Heng Chuah	53921/188	1636
27155	7590	03/24/2005	EXAMINER	
MCCARTHY TETRAULT LLP SUITE 4900, P.O. BOX 48 66 WELLINGTON ST. WEST TORONTO, ON M5K 1E6 CANADA			TABONE JR, JOHN J	
		ART UNIT		PAPER NUMBER
		2133		

DATE MAILED: 03/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

UW

Office Action Summary	Application No.	Applicant(s)	
	10/025,742	CHUAH ET AL.	
	Examiner	Art Unit	
	John J. Tabone, Jr.	2133	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 18 November 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-5, 7-11 and 13-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-5, 7-11 and 13-20 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 26 December 2001 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

FINAL DETAILED ACTION

1. Claims 1-5,7-11 and 13-20 have been examined. As a result of Applicant's amendment filed 11/18/2004 claims 1-5 and 7-11 are amended; claims 6 and 12 are canceled; and claims 13-20 are newly added.
2. The Applicant has not addressed the objection to the specification, according to paragraphs 2 and 3 of the Office Action of record, in this response. Therefore, the objections are maintained.
3. The claim objections have been withdrawn by the Examiner in response to Applicant's amendment.
4. Applicant's argument concerning the provisional double patenting rejection of claims 1-5 and 7-12 has not persuaded the Examiner. Therefore, rejection is maintained. Canceled claim 12 has been removed from the rejection.

Response to Arguments

5. Applicant's arguments with respect to independent claims 1 and 7 have been considered but are moot in view of the new ground(s) of rejection. New rejections for new claims 13-20 are included below.

The Applicant states "this feature of inserting a specialized diagnostic cell into a communication element carrying normal traffic data is not taught or suggested by Minami". However, Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims

Art Unit: 2133

present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections. In addition, Applicant's arguments do not contain the claim language of either claim 1 or 7.

It is the Examiner's conclusion that independent claims 1, and 7 are not patentably distinct or non-obvious over the prior arts of record namely, Minami (US-6141326). Therefore, the rejection is maintained. Based on their dependency on claims 1, and 7, claims 2-5 and 8-11, respectively, stand rejected.

Specification

6. The abstract of the disclosure is objected to because of improper grammar used on line 5, "...cell "to" adapted to be...". Remove the first "to". Correction is required.

See MPEP § 608.01(b).

7. The disclosure is objected to because of the following informalities: Fig. 2 on page 10, lines 6, 13 and 15 and page 14, lines 12 and 17 is improperly referenced.

Figure 2 does not exist in the disclosure. It appears that these references should be

Fig. 2B. Appropriate correction is required.

Double Patenting

8. Claims 1-5 and 7-11 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-5 and 10-15 of copending Application No. 10/025,741. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter in the conflicting claims cited above.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

In addition, 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-5,7-11 and 13-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Minami (US-6141326).

Claim 1 and 15:

Minami teaches of OC3C interface units 101 (uplink), 105 (downlink) has, a fault monitoring section 101c. Minami further discloses the fault monitoring section 101c (diagnostic cell) has (1) a cell error counter 101n (diagnostic cell counter module) counts up an error count En whenever notification of error detection is given by the first and second parity verifiers 101i, 101m, and (2) a passing cell counter 101p (diagnostic cell counter module) counts cells, which are sent from the interface 101f, on a per-connection-(VPI/VCI)-basis-to-thereby-monitor-the-number-of-passing-cells.-Minami-also-teaches-an-equipment-fault-information-separating-unit-101s-separates-and-outputs-equipment-fault-information-(analyzing-said-diagnostic-cell-counter-module)-(equipment-identification-information,-error-count-En,-passing-cell-count-Cn-for-every-connection)-sent-from-each-unit-(any-data-path)-upon-being-added-onto-intra-office-cells. (Col. 5, lines 12-24; col. 6 lines 23-28, 40-41).

Claim 7:

Minami teaches the fault monitoring section 101c has (1) a cell error counter 101n (first diagnostic cell counter module) counts up an error count En whenever notification of error detection is given by the first and second parity verifiers 101i, 101m, and (2) a passing cell counter 101p (first diagnostic cell counter module) counts cells, which are sent from the interface 101f, on a per-connection (VPI/VCI) basis to thereby monitor the number of passing cells. Minami also teaches an equipment fault information separating unit 101s (analysis module) separates and outputs equipment fault information (equipment identification information, error count En, passing cell count Cn for every connection) sent from each unit (any data path) upon being added onto intra-office cells. (Col. 5, lines 12-24; col. 6 lines 23-28, 40-41).

Claims 2, 8 and 16:

Minami teaches the processor 106 notifies the diagnostic apparatus 110 of the connection (VPI/VCI) in which the fault was detected and instructs the diagnostic apparatus 110 to perform a cell continuity test on the connection. Further, the processor 106 instructs the VCC setting unit of the common unit 102b to establish a path in such a manner that cells having the aforesaid connection will be looped back by the switch (hardware loop-back). Minami also teaches a cell error counter 101n (diagnostic cell counter module) counts up an error count En whenever notification of error detection is given by the first and second parity verifiers 101i, 101m, and a passing cell counter 101p (diagnostic cell counter module) counts cells, which are sent from the interface 101f, on a per-connection (VPI/VCI) basis to thereby monitor the number of passing cells. (Col. 6 lines 23-28, col. 10, lines 27-40).

Claims 3, 9 and 17:

Minami teaches that each of the fault messages M1, M2 includes (1) the unit that reported the low cell passing count, (2) the cause (CAUSE) of the fault, (3) whether the direction is the uplink or downlink (downstream) (UPLINK/DOWNLINK) direction, (4) the section in which the fault occurred (failure location), and (5) the connection (VPI/VCI), etc. (Col. 9, lines 1-10).

Claims 4, 10 and 18:

Minami teaches of OC3C interface units 101 (uplink), 105 (downlink) (second diagnostic cell counter) has, a fault monitoring section 105c. Minami also teaches a cell error counter 105n (second diagnostic cell counter module) counts up an error count En whenever notification of error detection is given by the first and second parity verifiers 101i, 101m, and a passing cell counter 101p (second diagnostic cell counter module) counts cells, which are sent from the interface 101f, on a per-connection (VPI/VCI) basis to thereby monitor the number of passing cells. (Col. 6 lines 23-28, col. 10, lines 27-40).

Claims 5, 11 and 19:

Minami teaches that each of the fault messages M1, M2 includes (1) the unit that reported the low cell passing count, (2) the cause (CAUSE) of the fault, (3) whether the direction is the uplink or downlink (downstream) (UPLINK/DOWNLINK) direction, (4) the section in which the fault occurred (failure location), and (5) the connection (VPI/VCI), etc. (Col. 9, lines 1-10).

Claim 13:

Minami teaches When the processor 106 concludes that a piece of equipment is suspected of being faulty, the processor instructs the active unit ACT to change over (**diagnostic cell is extracted from said data stream**). (Col. 9, l. 64 to col. 10, l. 13).

Claim 14:

"if a preset time has elapsed prior extraction of said diagnostic cell from said extraction location then an error condition is noted"

Minami teaches when an interrupt is applied by a timer 106a at first time intervals t, which are comparatively short, the software 106b starts up the units 101~105 and instructs them to send error information. Minami also teaches as a result, each unit adds equipment fault information classified by uplink/downlink direction onto intra-office cells and then transmits the cells. (Col. 7, ll. 57-64).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

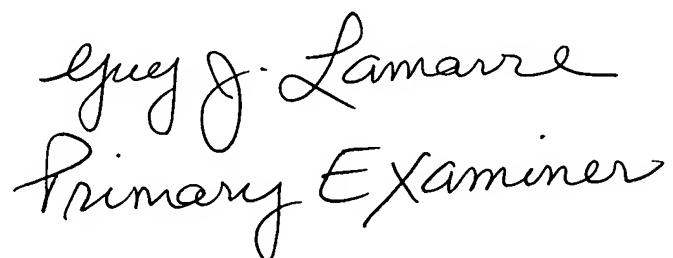
Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Tabone, Jr. whose telephone number is (571) 272-3827. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert DeCady can be reached on (571) 272-3819. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


John J. Tabone, Jr.
Examiner
Art Unit 2133


Suey J. Lamarre
Primary Examiner